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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,818	03/09/2004	H. Craig Dees	0546-0203.01	2064
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COOK ALEX LTD				
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200 WEST ADAMS STREET				
CHICAGO, IL 60606				
EXAMINER				
SUTTON, DARRYL C				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
08/06/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/796,818

**Applicant(s)**

DEES ET AL.

**Examiner**

DARRYL C. SUTTON

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5-7,9,10,13-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,9,10 and 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/25/2010 has been entered. No new claims have been added.

Applicant's arguments filed 06/25/2010 have been fully considered. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-7, 9, 10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholz (US 5,908,619) in view of Luu et al. (5,871,763).

Scholz teaches a hydroalcoholic composition comprised of a lower alcohol, i.e., ethanol, isopropanol, n-propanol (Abstract, column 4, lines 56-64). The composition is further comprised of secondary antimicrobials, such as triclosan, which are added to enhance the antimicrobial action of the compositions (column 17, lines 29-35, 41-43). The compositions are useful as lotions; lotions are defined as liquid or cream, free of propellant (column 1, lines 6-8, column 4, line 5). The composition can be formulated into aerosols (column 18, lines 15-17). The composition can be incorporated into a polymeric material such as a hydrogel layer (column 19, lines 58-61). In order to reduce irritation, and yet maintain efficacy, the secondary antimicrobial level should be adjusted to the minimum level which maintains a low bacteriological count (column 17, lines 45-49). The compositions have an alcohol to water ratio of no greater than 99:1 by weight. Compositions having a ratio within the range of about 40:60 to 95:5 (i.e. the solvent is 40-95% alcohol) ensure an efficacious immediate bacterial kill (column 5, lines 9-16). Amounts of alcohol/water solvent used in the compositions range from 82% to 92% (column 22, lines 53-65). Accordingly, amounts of alcohol provided by the alcohol/water solvent present in the compositions that ensures an efficacious immediate bacterial kill range from about 32.8% to about 87.4%.

Scholz does not teach the specific amount of volatile biocide or triclosan.

Luu et al. teach a substrate treated with lotion (Abstract). The lotion transfers to the skin during use (column 1, lines 6-10). The lotion contains one or more optional

ingredients, which include a medicinal agent such as an antimicrobial agent which kills bacteria (column 1, lines 11-13 and column 4, lines 24-31). The antibacterial agent will kill bacteria found on skin thereby providing enhanced cleaning and deodorizing benefit (column 4, lines 26-33). The antibacterial agent can be present in an amount from about 0.01% to about 10%; and include triclosan (column 9, lines 23-38).

Luu et al. do not teach a lotion comprised of an alcohol-based volatile biocide compound.

Scholz et al do not teach the specific amount of volatile biocide. The prior art does not disclose the exact claimed values, but does overlap: in such instances even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Scholz et al. teach from about 32.8% to about 87.4% versus greater than or equal to 30% to less than or equal to 70%.

Since Luu et al. teach that triclosan in amounts from about 0.01% to about 10% is used as an antibacterial agent in lotions that are transferred to the skin, it would have been obvious to modify the composition of Scholz et al. to include triclosan in those amounts as a secondary antimicrobial in the lotions of Scholz in order to enhance the antimicrobial action of the compositions as taught by Scholz et al.

Luu et al. does not teach the specific range of triclosan. The prior art does not disclose the exact claimed values, but does overlap: in such instances even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Luu et al. teach about 0.01% to about 10%

versus greater than 0% to less than or equal to 0.01% and greater than or equal to 0.001% to less than or equal to 0.01% of the instant claims.

### ***Applicant's Arguments***

Applicant argues that the claimed sanitizing composition achieves unanticipated synergistic bactericidal activity.

The Examiner disagrees.

The Examiner's response to allegations of unexpected results has been presented previously in the Final office action dated 12/31/2009 and is still applicable, see pages 4 and 5.

Applicant argues that there is no motivation for one of skill in the art to combine the disclosure of Luu with Scholz. Scholz concerns topical agents for direct application to the skin, whereas Luu concerns certain emollient lotions adapted for application to solid substrates. The compositions of Luu are fundamentally unrelated to the compositions of Scholz. A key component of Luu is one or more emollients and Luu makes no reference or suggestion of a volatile alcohol. The volatile alcohols of Scholz are unrelated to the emollients of Luu. Luu makes a passing reference to inclusion of optional ingredients for the lotion. This contrasts to the central role of such components play in Scholz. Triclosan is disclosed as a member of a lengthy list of medicinal agents; and Luu does not provide any data on formulations actually containing triclosan or any

guidance on the selection of concentration within this generic range. There is no reason to selectively combine miniscule portions of Luu's disclosure with other portions of Scholz.

The Examiner disagrees.

As cited previously in the Final office action dated 12/31/2009 and *supra*, both Scholz and Luu et al. disclose lotions for the skin which utilize triclosan as an antibacterial agent. This provides adequate motivation for combining the prior art. Since Scholz discloses triclosan, but not any disclosure on the amounts of triclosan, the disclosure of Luu et al., i.e. triclosan having antibacterial activity at concentrations of about 0.01 to 10%, would provide adequate motivation for using these amounts in the composition of Scholz. Further, since Scholz teaches that the secondary antimicrobial agent, i.e. triclosan, enhances the antimicrobial activity and should be adjusted to the minimum level which maintains a low bacteriological count, it would have been obvious to optimize the antimicrobial activity of the composition suggested by combining Scholz and Luu et al. through routine experimentation by varying the triclosan level to values of about 0.01%, i.e. above and below 0.01%, to reach said minimum level.

All claims are rejected.

### ***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl C. Sutton whose telephone number is (571)270-3286. The examiner can normally be reached on M-Th from 7:30AM to 5:00PM EST or on Fr from 7:30AM to 4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass, can be reached at (571)272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Darryl C Sutton/  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612